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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,653	09/30/2003	Marc E. Feinberg	ETH5092	4786
27779	7590	03/17/2008		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER  RYCKMAN, MELISSA K	
			ART UNIT	PAPER NUMBER
			3773	
			MAIL DATE	DELIVERY MODE
			03/17/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/674,653

**Applicant(s)**

FEINBERG, MARC E.

**Examiner**

MELISSA RYCKMAN

**Art Unit**

3773

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-6, 8, 14, 21, 22 and 27-50 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 14, 21, 22, 27-37, 43-45, 49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 6, 8, 38-42 and 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 3,4,14,22,27-30,36,37,49 and 50 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups II and III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/30/07.

Applicant's election with traverse of Group 1, claims 3-6, 8, 38-42 and 46-48 in the reply filed on 11/30/07 is acknowledged. The traversal is on the ground(s) that Group 1 and Group 2 are not in separate and distinct states in the art. This is not found persuasive because a restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because **one or more** of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

This restriction is applicable to portion (e) above. The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 46-48 recites the limitation "the distal end" in the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5, 6, 8, 38-42, 46 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al. (US 6394951).

Regarding Claim 8, Taylor teaches a tissue approximation device comprising two elongate arms (3), an attachment means (144) to secure the elongate arms to each other at one or more locations, adhesive pads (4, Column 14, proximate lines 1-37) movably connected (18, 19) on at least a portion of the elongate arms to anchor the

tissue approximation device to the tissue (fig. 321a), and a locking means (181) to lock the elongate arms in place relative to each other, wherein (i) the adhesive pads are spaced apart from the one or more locations of the attachment means (144) in the direction of the elongate arms, and (ii) the tissue approximation device has an open (fig. 31b) and a closed position (fig. 31a), and when in the closed position, the adhesive pads are parallel and non-contiguous to each other (fig. 31a).

Taylor teaches the second surface rotatably couple to the distal end of each of the elongate arms by a ball and socket connector (18 and 19, Fig. 2), wherein the second surface has one of a socket and a ball that communicates with the other one of a ball and a socket on the distal end of each of the elongate arms, and the adhesive pad is rotatable around the ball about at least two axes (slight rotation is possible along two axes).

Regarding Claim 5, Taylor teaches the tissue approximation device of claim 1, wherein the elongate arms (3) form a pair of forceps, the attachment means (144) is a yoke on the forceps, and the locking means (151) is a ratchet mechanism on the forceps.

Regarding Claim 6, Taylor teaches the tissue approximation device of claim 5, wherein the distance between the elongate arms is adjustable by means of a ratchet mechanism (151).

Regarding Claim 38, Taylor teaches a tissue approximation device capable of application to a skin surface adjacent to a wound comprising: a pair of arms (3), each arm having a longitudinal axis and opposed ends, wherein one end includes a handle

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(fig. 31a) and the other end includes a tong (1) with a connector (19); and an attachment mechanism coupled to each arm (144) such that the distance between each tong is selectively variable; an adhesive pad (4) removably coupled to the connector of each tong (18) wherein each adhesive pad has an adhesive surface (4) that extends in a plane generally parallel to the longitudinal axis of the respective tong (fig. 2), the adhesive surface having a high shear resistance, and wherein the connectors support the adhesive pads to be positionable in a common plane on opposed sides of a wound; and a locking mechanism (151) coupled to each arm to selectively lock the pair of arms in a fixed position relative to each other, wherein the connector is a rotatable connector (ball and socket, Fig. 2, 18 and 19) that connects the adhesive pad (4) to the tong to pivot at least about the longitudinal axis and an axis substantially perpendicular to the longitudinal axis (capable of small pivot in longitudinal axis) and the rotatable connector is one of a ball and a socket and the adhesive pad includes the other of the ball and the socket, wherein the ball and socket are snap fit together in an interference fit (Fig. 2).

Regarding Claim 39, Taylor teaches the arms are connected in a scissors configuration (fig. 31a)

Regarding Claim 40, Taylor teaches the adhesive pad (4) includes serrations.

Regarding Claim 41, Taylor teaches the locking mechanism (151) includes a ratchet.

Regarding Claim 42, Taylor teaches the arms (3) are made of resilient material (Column 12, proximate lines 50-60, it is noted that the present application only

describes that the arms may be made of either plastic or stainless steel, as taught by Taylor).

Regarding Claim 46, Taylor teaches the second surface has the socket (19) and the distal end has the ball (18, Fig. 2).

Regarding Claim 47, Taylor teaches the second surface has the ball (18) and the distal end has the socket (18, Fig. 2).

Regarding Claim 48, Taylor teaches the second surface and the distal end of the elongate arm connect in a snap fit manner (Fig. 2).

### ***Response to Arguments***

Applicant's arguments filed 8/23/07 and 11/30/07 have been fully considered but they are not persuasive. The applicant generally argues the following regarding the pending claims (many arguments were directed to claims that were restricted and have since been withdrawn):

- Taylor does not teach a movable ball and socket connection

The examiner's position is that the ball and socket (18 and 19, Fig. 2) of Taylor is movable to a small degree, it is capable of being moved.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RYCKMAN whose telephone number is (571)272-9969. The examiner can normally be reached on Monday thru Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773